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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,311	12/17/2001	Jeffrey D. Sheely	56695US002	6642

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EXAMINER

RUDDOCK, ULA CORINNA

ART UNIT	PAPER NUMBER
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1771

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Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/024,311
Filing Date: December 17, 2001
Appellant(s): SHEELY, JEFFREY D.

William L. Huebsch
For Appellant

MAILED
OCT 20 2004
GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 2, 2004.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2) ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because merely reciting claim limitations is not a proper argument. Therefore, all claims stand together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,407,726	SERRA et al.	4-1995
6,331,343	PEREZ et al.	12-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 6-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Serra et al. (US 5,407,726). Serra et al.

disclose adhesive tapes comprising polymeric backing layer and a pressure sensitive adhesive layer (abstract). The backing layer comprises polyethylene (col 2, ln 26-32), which is the same type of backing layer used by Applicant (page 3, line 19 of the present specification). A reinforcing nonwoven scrim may be incorporated into the tape to enhance tearability and strength and can comprise either polyester or cotton (col 3, ln 19-47). A portion of the adhesive layer will be present in the interstices of the scrim (col 3, ln 27-29).

Serra et al. disclose the claimed invention except for the teaching that the index of refraction of the material of the fibers is within plus or minus 0.2 of the index of refraction of the adhesive and the percentage of light reflected from the tape as diffuse light was at least 15% before the tape was adhered to a substrate and was reduced by at least 10% or 60% by adhering the tape to the substrate.

Although Serra et al. do not explicitly teach the claimed index refraction of the fibers and adhesive or the percentage of reflected light before and after adhering the tape to a substrate, it is reasonable to presume that these properties is inherent to the Serra et al. invention. Support for said presumption is found in the use of like materials (i.e. polyester or cotton nonwoven scrims, polyethylene backing layers, and adhesive layers). The burden is upon Applicant to provide otherwise. In addition, the presently claimed property of the index of refraction of the material of the fibers being within plus or minus 0.2 of the index of refraction of the adhesive and the percentage of light being reflected from the tape as diffuse light was at least 15% before the tape was adhered to a substrate and was reduced by at least 10% or 60% by adhering the tape to the substrate would obviously have been present once the Serra et al. product is provided.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serra et al. (US 5,407,726), as shown above, in view of Perez et al. (US 6,331,343). Serra et al. disclose the claimed invention except for the teaching that the scrim is formed of bundles.

Perez et al. disclose fibrous films used in tape backings (col 1, ln 11-12). The fibrous films are made of fiber or fiber bundles (col 15, ln 22 and col 17, ln 19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used Perez's fiber bundles as the fibers of the scrim of Serra et al. motivated by the desire to create a tape that has a high modulus and tensile strength.

With regard to claims 3 and 5, Serra et al. disclose that the fibers have a denier of approximately 200 denier (col 4, ln 16) and that the tape has finger tearability (col 3, ln 26).

(11) Response to Argument

Appellant argues that the holding in *In re Fitzgerald* is not applicable because the claims in the subject application are not product by process claims. While the Examiner appreciates the discussion, the application of the Serra et al. reference is still viable, case law notwithstanding. Appellant has provided no evidence to the contrary considering Serra et al. disclose the same materials in their adhesive tape (e.g. polyester or cotton nonwoven scrims, polyethylene backing layers, and acrylic adhesive layer).

Appellant also argues that Serra et al. do not teach or suggest that both, or even either one of their backing layer and their layer of adhesive should be visually transparent. This argument is also not persuasive because while Serra et al. does fail to explicitly teach that the backing and adhesive layers are visually transparent, because the same materials in Serra et al. and the

present invention are being used, both layers will be visually transparent. The specification of the present invention, on page 10, lines 4-5, lists two patents that disclose the typical visually transparent pressure sensitive adhesive used in the present invention. It should be noted that Hamer et al. (US 5,804,610) discloses adhesives made of acrylic at column 6, lines 26-30), which is the same adhesive used in the Serra et al. invention (col 2, ln 41-44). Therefore, the very same adhesive that Appellant discloses as being visually transparent is shown and taught by the Serra et al. invention. Furthermore, the backing layer of Serra et al. comprises polyethylene (col 2, ln 26-32), which is the same type of backing layer used by Appellant (page 3, line 19 of the present specification). Therefore, it is the Examiner's position that because Serra's adhesive tape comprises the same backing layer (i.e. polyethylene) and the same adhesive (i.e. acrylic adhesive) as the present invention, these two components will also be visually transparent as required in Appellant's invention.

Appellant also argues that Serra et al. provide no teaching to provide a tape in which only portions of a reinforcing scrim are wetting by an adhesive covering the reinforcing scrim. This argument is not persuasive because Serra et al. teach that the adhesive layer is present in the interstices of the scrim. Therefore, the Examiner is equating the interstices of Serra's scrim to the portions of the scrim in Appellant's invention that are wetted by the adhesive. Furthermore, Appellant fails to define in the claims exactly how much of the scrim is being wetted by the adhesive, i.e. Appellant fails to define "only portions."

Appellant also argues some of the adhesives suggested by Serra et al. may have indexes of refraction that are not similar to such fibers. This argument is not persuasive because

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Appellant's claims fail to limit the claims to the use of a specific adhesive. As shown above, Serra et al. discloses the same acrylic adhesive disclosed by the present specification and the same fibrous polyester or cotton nonwoven scrim. Therefore, if the same adhesive and fibers are being used in the Serra et al. tape as disclosed by Appellant's invention, then the indexes of refraction of the adhesive and fibers would be similar, as required by Appellant's claims.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ula Ruddock
ULA RUDDOCK
PRIMARY EXAMINER

Ula C. Ruddock *Ula*
October 16, 2004

Conferees:

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